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D-1147 R1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:)
 Jay Paul Drummond, et al.)
) Art Unit 3624
Serial No.: 09/966,909)
)
Confirm. No.: 5701)
)
Filed: September 27, 2001)
) Patent Examiner
For: AUTOMATED BANKING)
) Alain L. Bashore
) MACHINE SYSTEM AND
) METHOD)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 41.41 concerning the above-referenced Application. The Reply Brief is in response to the Examiner's Answer ("Answer") dated April 30, 2007.

STATUS OF CLAIMS

Claims 1-20 are pending in the Application.

Claims rejected: 1-20

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claims objected to: none

Claims canceled: none

Appellants appeal the rejections of claims 1-20. These claim rejections were the only claim rejections present in the Office Action ("Action") dated June 7, 2006, which re-opened prosecution after Appellants' first appeal to the Board. Claims 1-20 have been at least twice rejected.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds to be reviewed in this appeal are:

Whether Appellants' claim 17 is indefinite pursuant to 35 U.S.C. § 112, second paragraph;

Whether Appellants' claims 1, 4, 6 and 18 are unpatentable pursuant to 35 U.S.C. § 102(e) as being anticipated by Joao, et al., U.S. Publication No. US 2001/0051920 ("Joao") or in the alternative are unpatentable pursuant to 35 U.S.C. § 103(a) as being obvious over Joao;

Whether Appellants' claims 7, 11, and 16-17 are unpatentable pursuant to 35 U.S.C. § 103(a) as being obvious over Joao in view of Stewart, et al., U.S. Patent No. 6,732,176 ("Stewart");

Whether Appellants' claims 5 and 13-15 are unpatentable pursuant to 35 U.S.C. § 103(a) as being obvious over Joao in view of Bansal, et al., U.S. Patent No. 6,439,456 ("Bansal");

Whether Appellants' claims 2 and 19-20 are unpatentable pursuant to 35 U.S.C. § 103(a) as being obvious over Joao in view of Laybourn Laybourn, et al., U.S. Patent No. 6,480,710 ("Laybourn");

Whether Appellants' claims 9-10 are unpatentable pursuant to 35 U.S.C. § 103(a) as being obvious over Joao in view of Stewart and Laybourn; and

Whether Appellants' claims 3, 8, 12 are unpatentable pursuant to 35 U.S.C. § 103(a) over Joao in view of Jones et al., U.S. Patent No. 5,905,810 ("Jones");

Additional Note:

Claims 1, 6, and 18 were rejected as being unpatentable on the ground of non-statutory obviousness-type double patenting over claims 1, 6, 15, 19, 20-21 of Drummond, et al., U.S. Patent No. 6,796,490 ("Drummond"). Appellants submit herewith a terminal disclaimer which renders this rejection moot.

ARGUMENT

The Answer includes a "(9) Grounds of Rejection" section beginning on page 4. The remaining arguments made in the grounds of rejection included in this section of the Answer appear to correspond to those previously presented in the Office Action dated June 7, 2006. Appellants' Supplemental Appeal Brief filed on December 11, 2006 is incorporated herein by reference. Appellants respectfully submit that most of these rejections have been addressed in Appellants' Appeal Brief, and Appellants have shown that these rejections should be reversed. Therefore, please refer to Appellants' previous arguments in the Appeal Brief regarding the issues of record.

In addition, some of the rejections in the Answer have been changed relative to the last Action. For example, in addition to claims 1, 4, 6 and 18 being rejected under 35 U.S.C. § 102(e) as being anticipated by Joao, the Answer also rejects these claims in the alternative pursuant to 35 U.S.C. § 103(a) as being obvious over Joao. Appellants' arguments made in the Appeal Brief regarding claims 1, 4, 6 and 18 point out examples of features, relationships, and steps which are not disclosed or suggested in Joao. The Answer has still not shown where these features, relationships and steps are found in Joao or any other applied art. Thus the Answer has not established a case of *prima facie* obviousness with respect to the rejections of claims 1, 4, 6, and 18 in view of Joao and the rejections of claims 1, 4, 6, and 18 under 35 U.S.C. § 103(a) should be reversed as well.

Also, the Answer has revised the rejections of claims 9-10 to be rejected under 35 U.S.C. § 103(a) as being obvious over Joao in view of Stewart and Laybourn. This new rejection has also been addressed in the Appeal Brief.

In addition, the following arguments specifically reply to the new assertions made in the Answer. However, even though the present reply has been organized in a manner which addresses issues and arguments as presented in the Answer, Appellants do not waive their right to have all of their claims, each of which was separately argued in the Appeal Brief, considered independently of each other by the Board. If the Board has an unwritten policy which considers the format of the present Reply Brief to be a waiver of Appellants' right to have each separately argued claim in the Appeal Brief be independently considered by the Board, then Appellants respectfully request that the Board so notify Appellants and provide an opportunity for Appellants to submit a revised Reply Brief.

Response to Arguments in Examiner's Answer

Beginning at the bottom of page 6 of the Examiner's Answer, there is a section labeled "(10) Response to Arguments" which presents additional arguments in response to Appellants' Appeal Brief. Appellants respectfully submit that these additional arguments do not overcome the numerous deficiencies in the rejections pointed out in Appellants' Appeal Brief. The Examiner has again failed to establish that each of the recited elements, features, relationships, and steps pointed out in the Appeal Brief as missing in the applied art, can be found in the prior art. The Examiner has not established anticipation or *prima facie* obviousness based on the applied art. Therefore it is respectfully submitted that all of the rejections of claims 1-20 should be reversed.

Claim 17

Claim 17 depends from claim 16 and recites that the wireless access hub enables RF communication over relatively short distance with the at least one portable wireless device. The Action indicated that the recitation in claim 17 of "relatively short" is considered vague and indefinite. Appellants respectfully disagree.

Appellants' specification discloses at page 11, line 20 to page 12, line 1 that "alternative exemplary embodiments of the system 80 may use any other wireless network interfaces and systems between the portable wireless devices and the ATM, including for example generally short range RF communication such as Bluetooth™ and IR based systems." One skilled in the art would recognize that the recited feature of "RF communication over relatively short distances" corresponds to the distances associated with short range RF communications carried out using Bluetooth™ RF communication systems for example. Once skill in the art would also recognize that the term "relatively" is with respect to other types of RF communication systems described in the specification which allow communication over longer distances such as IEEE 802.11b compatible wireless network interface described at page 11, lines 18-20.

With respect to the art of wireless access hubs, one skilled in the art would regard "RF communication over relatively short distance" as being definite and clear in view of the manner in which the Specification provides an enabling disclosure of this feature with respect to Bluetooth™ and IR based systems.

Thus claim 17 is not vague and indefinite in view of the Specification. It follows that the 35 U.S.C. § 112, second paragraph rejection of claim 17 should be reversed.

Claims 1, 4, 6, and 18

With respect to claims 1, 4, 6, and 18, the Answer confirms at page 10 that the Office regards:

- the "electronic cash transaction device" of Joao as corresponding to the recited element of an "automated banking machine."
- the "CPU" of Joao as corresponding to the recited element of a "server"
- the "portable [communication] device" of Joao as corresponding to the recited element of a "portable wireless device"

With respect to these elements, the Answer refers to Figure 10 and paragraphs [0254]-[0255] of Joao as disclosing the order of communication as "a portable device can go to bank to server and back to bank and back to portable device."

Appellants respectfully disagree with this assertion. Nowhere does Joao disclose or suggest such an order of communication. For example, paragraph [0254] states that:

- The apparatus 300 also comprises an account owner communication device 304 which may receive signals and/or data from either or both of the electronic cash device 302 and/or the central processing computer 303.
- In the preferred embodiment of FIG. 10, the communication device 304 receives signals and/or data from the central processing computer 303 with said signals being transmitted via a suitable communication system. In the preferred embodiment, the communications system utilized for transmitting signals and/or data to the communication device 304 is a wireless telephone line and the communication device 304 is a wireless telephone signal receiving device such as a telephone beeper or pager.
- The communication device 304, which may be a pager, receives the wireless telephone signals and/or data from the central processing computer 303 during the authorization procedure as will be described in more detail below.

In terms of the elements recited in Appellants' claims that allegedly correspond to the elements disclosed in Joao, this paragraph at best would translate to the following:

- a **portable wireless device** receives signals/data from either or both of an **automated banking machine** and/or a **server**.
- a **portable wireless device** receives signals/data from a **server** transmitted through a suitable communication system such as a wireless telephone line
- a **portable wireless device** receives wireless telephone signals/data from a **server**

Also for example paragraph [0255] of Joao states that:

- In the preferred embodiment, the communication device 304 is also equipped with a transmitter for transmitting signals and/or data to the central processing computer 303.
- In this regard, the central processing computer 303 transmits signals and/or data to the communication device 304 as well as receives signals and/or data from the communication device 304.
- The communication device 304 may also transmit signals and/or data directly to the electronic cash device 302 and receive signals and/or data directly from the electronic cash device 302.
- In the preferred embodiment, the electronic cash device 302 transmits signals and/or data to the central processing computer 303 and receives signals and/or data from the central processing computer 303.
- Further, in the preferred embodiment, the communication device 304 receives signals and/or data from the central processing computer 303 and transmits signals and/or data to the central processing computer 303.

In terms of the elements recited in Appellants' claims that according to the Office allegedly correspond to the elements disclosed in Joao, this paragraph of Joao at best would translate to the following:

- The **portable wireless device** transmits signals/data to a **server**
- The **server** transmits/receives signals/data to/from the **portable wireless device**

- The portable wireless device transmits/receives signals/data directly to/from the automated banking machine
- The automated banking machine transmits/receives signals/data to/from the server
- The portable wireless device receives/transmits signals/data from/to the server

The described flow and alternative flows of communication in paragraphs [0254] and [0255] of Joao is consistent with the description in Joao of a system that uses the CPU (303) to automatically notify users by telephone, pager, etc., that a transaction is being carried out with one of their accounts (e.g. credit card) and enables the user to authorize or cancel the transaction (Figures 3A-3C). As shown in Figure 10, the CPU (303) (the alleged server) is operatively positioned in between the electronic cash transaction device (302) and the communication device (304). As shown in Figure 12, and discussed in paragraphs [0267] to [0282] of Joao the flow of communication for a transaction is from the electronic cash transaction device to the CPU and then to the communication device. The communication device then responds, in which case communication goes from the communication device to the CPU to electronic cash transaction device. Alternatively, the communication device of Joao can directly communicate with the electronic cash transaction device (bypassing the CPU) to authorize or cancel the transaction.

This flow of communication in Joao does not correspond to the flow of communication recited in Appellants' claim 1. For example, as shown in Figure 4, and recited in claim 1, the automated banking machine or ATM (82) is in between the flow of communication between the portable wireless device (86, 88, 90) and a server on a wide area network such as the Internet

(94). Nowhere does Joao disclose or suggest that its electronic cash transaction device (the alleged automated banking machine) is ever in between the flow of communication taking place between the communication device (the Office's alleged Joao portable wireless device) and the CPU (the Office's alleged Joao server). Nowhere does Joao disclose or suggest a flow of communication as recited in steps (a) through (d) of Appellants' claim 1 which goes from a portable wireless device to an automated banking machine and then to a server, and then the communication flows from the server to the automated banking machine and then to the portable wireless device.

In paragraph [0254] Joao describes "a suitable communication system" between the communication device 304 and the central processing computer 303 as corresponding to "wireless telephone line." Nowhere does Joao disclose or suggest that such "a suitable communication system" could ever correspond to its described "electronic cash device." Thus nowhere does Joao disclose or suggest as asserted in the Answer, that "a portable device can go to bank to server and back to bank and back to portable device." The Office has not established *prima facie* obviousness with respect to the steps recited in claim 1.

In addition it would not be obvious to modify Joao to carry out Appellants' recited steps. Objects of Joao involve the ability of its system to notify users remotely of use of their credit card so that the user can authorize or disapprove the transaction in real time (See paragraph [0078]). The system of Joao is not directed to a system and method as recited in Appellants' claims, which enable a portable wireless device to access servers on a wide area network such as the Internet through communication with an automated banking machine such as an ATM. One with ordinary skill in the art would have no reason in view of the teachings of Joao to modify Joao

to use an automated banking machine to provide a portable wireless device with wide area network access to a remote server.

Reversal of the rejections under 35 U.S.C. § 102(e) and/or 103(a) of claim 1, as well as claims 2-6 and 18-20 which depend therefrom and which distinguish over the cited art on the same basis as claim 1, is respectfully requested.

Claims 7, 11, and 16-17

The Answer alleges that it would have been obvious to one with ordinary skill in the art to include a wireless access hub as recited in claims 7, 11, and 16-18 because Stewart teaches a hub access useful in a business environment at column 1, lines 26-43. However, as admitted in the Answer, Stewart does not disclose an automated banking machine or an ATM. Thus neither Stewart nor Joao discloses or suggests a wireless access hub in operative connection with a computer included in an automated banking machine computer.

Further, column 1, lines 26-43 does not provide any apparent reason to modify an automated banking machine to include a wireless access hub. Column 1, lines 26-43 of Stewart discuss that numerous providers are attempting to install wireless network infrastructures in various locations, such as airports, hotels, office buildings, etc. for use by various users. Such locations do not correspond to an automated banking machine. Further, if such locations already include a wireless network infrastructure, Stewart teaches away from any need to modify an automated banking machine to include a wireless access hub.

Neither Joao nor Stewart discloses or suggests any need for Joao's electronic cash transaction device to include a wireless access point. Also, neither Joao nor Stewart discloses or

suggests modifying an automated banking machine to include a wireless hub that enables the automated banking machine to communicate with at least one portable wireless device. Further neither Joao nor Stewart discloses or suggests an automated banking machine which communicates with a portable wireless device using a wireless access hub. In addition, neither reference discloses nor suggests an automated banking machine that is operative to enable the at least one portable wireless device to communicate in the wide area network. Also, neither Joao nor Stewart discloses or suggests an automated banking machine which enables communications between a portable wireless device and a wide area network.

Reversal of the rejections under 103(a) of claim 7 as well as claims 8-17 which depend therefrom is respectfully requested.

Claims 5, 13-15

The Answer alleges that claims 5, 13-15 are obvious in view of Joao and Bansal because since there is a debit from a cash card disclosed, there must be a modifying of data representative of cash value. However, regardless of whether Bansal shows modifying cash value in a cash card, nowhere does Joao or Bansal disclose or suggest the Appellants' recited feature of "modifying the data representative of cash value" in a portable wireless device "responsive to operation of the banking machine" to which the portable wireless device communicates.

In addition the Answer suggests an alternative interpretation in which the cash card of Bansal corresponds to a banking machine. However, such an interpretation is not consistent with the teachings of Joao or Bansal. Even if it were possible for a cash card to correspond to an automated banking machine (which it is not), neither Joao nor Basal discloses or suggests a card in the form of a banking machine that carries out step (b) of Appellants' claim 1. Nowhere is

there any disclosure or suggestion of sending through operation of a card (the alleged "banking machine") at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the card through a wide area network.

Reversal of the rejections under 103(a) of claim 5 as well as claims 13-15 which distinguish over the cited art on the same basis, is respectfully submitted.

Claims 2 and 9-10

The Answer alleges with respect to claims 2 and 9-10 that the claims do not preclude a monthly service fee as the fee required to communicate. However, it is unclear why whether or not the claims preclude a monthly service fee, is in any way relevant to the rejections.

Laybourn indicates that subscribers of wireless phone services pay a monthly subscriber fee for access to a wireless service (Column 1, lines 18-22). Laybourn does not disclose or suggest an automated banking machine and does not disclose or suggest wireless communication between an automated banking machine, and a portable wireless device. Thus, how can it be obvious to one with ordinary skill in the art to include subscriber fees for wireless phone service from Laybourn in an automated banking machine, when neither Joao nor Laybourn teaches or suggests any need for an automated banking machine to provide wireless services to a phone or any other portable wireless?

Reversal of the rejections under 103(a) of claim 2 as well as claims 9-10 which distinguish over the cited art for the same reasons, is respectfully submitted.

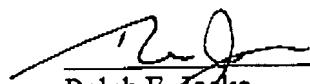
Claims 1, 6, and 18

Claims 1, 6, and 18 were rejected on the ground of non-statutory obviousness-type double patenting over claims 1, 6, 15, 19, 20-21 of Drummond. This rejection is respectfully traversed. Nevertheless to further prosecution of the application, Appellants have submitted herewith a terminal disclaimer to obviate the double patenting rejection (37 C.F.R. 1.321(c)).

CONCLUSION

Each of Appellants' pending claims specifically recites elements, features, relationships, and steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for producing the recited invention. For these reasons, it is respectfully submitted that all of the rejections should be reversed.

Respectfully submitted,


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